

**REMARKS**

This Amendment responds to the Office Action dated November 8, 2004 in which the Examiner rejected claims 3 and 4 under 35 U.S.C. §112 second paragraph, rejected claims 1-12 under 35 U.S.C. §101, rejected claims 1-10 and 12-14 under 35 U.S.C. §102(e) and rejected claim 11 under 35 U.S.C. §103.

As indicated above, a minor informality in the specification has been corrected. Applicants respectfully request the Examiner approves the correction.

As indicated above, claim 3 has been amended in order to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 3-4 under 35 U.S.C. §112 second paragraph.

As indicated above, claims 1-12 have been amended to be directed to statutory subject matter. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 1-12 under 35 U.S.C. §101.

Claims 1-10 and 12-14 were rejected under 35 U.S.C. §102(e) as being anticipated by *Hart Jr. et al.* (U.S. Patent No. 6,714,835).

*Hart Jr. et al.* appears to disclose systems and apparatus for the preparation of documents and the assembly of multiple mailpieces including such documents. (col. 1, lines 15-17) Inserter systems for the assembly of mailpieces are well known. A typical inserter system is shown in FIG. 1. Inserter system 10 includes burster/feeder 12 which inputs preprinted documents in fanfold form, separates the documents and removes and discards sprocket feed strips FS from the edges of the document. Each group of documents for a particular mailpiece includes at least control document CD. On control documents CD strips FS are marked with code BC

which is read by scanner 14 before strips FS are removed. In simpler systems code BC can be a "dash code" of the type known for use in directly controlling inserter systems. In newer, more complex systems code BC can be a conventional bar code which serves as a pointer to a mailpiece record which record contains information for controlling the inserter. (col. 1, lines 32-46) FIG. 2 shows mail preparation system 40 which includes data processing system 42 and mailpiece assembly system 50. Data processing system 42 is programmed in a conventional manner to generate documents 46, which include control documents CD and associated documents P; with one control document CD and its associated documents P being associated with each mailpiece, wherein control documents CD are marked with barcode pointers to mailpiece records in the manner described above. In the embodiment shown, system 42 controls printer 44 to print documents 46 directly and documents 46 are transported physically for assembly. (col. 3, lines 50-62) Data processing system 42 also generates and outputs mailing control file 80, shown in FIG. 3A, which includes header 82 and a plurality of mailpiece records 84-1 through 84-N, in a conventional manner. Mailpiece records 84-1 through 84-N each include a plurality of fields 86A-86F containing data for controlling assembly of the mailpiece. In a preferred embodiment, the mailing control file also includes data in header 82, shown in FIG. 3B, for defining set-up parameters for the mailing job corresponding to file 80. (col. 3, line 66 through col. 4, line 8) FIG. 3C shows typical mailing record 84-M. (In general, the content and format of mailpiece records can be freely specified by system users. However, the record must include an index, or identification code, which establishes correspondence between the record and a corresponding mailpiece.) (col. 4, line 24-29) Turning to FIGS. 4A, B, and C, a high

level flow diagram of the set-up of mailpiece assembly system 50 in accordance with the method of the subject invention is shown. At 100 a selected controller, hereinafter assumed for purposes of explanation to be controller 52A, inputs an ID for a mailing job assigned through manager's workstation 66. In other embodiments the mailing job ID can be read from the first mailpiece, or input in any convenient manner. At 102 controller 52A accesses the corresponding mailing control file in database 60 through file server 58. (In other equivalent embodiments workstation 66 directs server 58 to download the selected mailing control file to controller 52A.) Then at 104 controller 52A tests to determine if an appropriate matching control file has been found, and if not at 106 exits to error routine 110. If the appropriate mailing control file is found controller 52A continues to 112 to input the appropriate mailing control file. Then at 114 controller 52A accesses the set-up parameter values for the current mailing job, and at 118 outputs control signals to set-up inserter system 10A in accordance with those parameter values. The set-up parameter values are accessed either from header 82 or, in other preferred embodiments, from a separate file, as described above. Other parameter values, such as document priorities and document weights, are used directly by controller 52A to process the mailing job in a manner which is well known to those skilled in the art. Typically, for example, controller 52A can use document weights and priorities to select a subset of inserts specified for mailpiece to remain within a current weight break and avoid an increase required postage. At 120 controller 52A tests to determine if inserter system 10A is ready and has responded to the control signals; that is documents, inserts, envelopes, etc. have been loaded, needed stations of inserter system 10A have been activated, and all necessary preparatory actions have been taken, as will be

well understood by those skilled in the art. If system 10A is not ready then at 122 controller 52A loops back through 120 to wait for a ready condition. Otherwise at 124 controller 52A controls inserter system 10A to process the mailing job in accordance with records 84-1 through 84-N in a manner which is well known to those skilled in the art and which need not be described further. (col. 5, lines 10-53)

Thus, *Hart Jr. et al.* merely discloses a control document CD which is marked with bar code pointers to mailpiece records (col. 3, lines 55-59). Nothing in *Hart Jr. et al.* shows, teaches or suggests a) a sensor which senses and registers a physical postal item as claimed in claim 13, b) scanning and registering a property from a physical postal item as claimed in claim 1 or c) extracting and registering a property from a physical postal item as claimed in claim 12. Rather, *Hart Jr. et al.* merely discloses a control document which is marked with a bar code pointer to mailpiece records (i.e., the control document is not a postal item).

Additionally, *Hart Jr. et al.* merely discloses bar codes which are pointers to mailpiece records. Nothing in *Hart Jr. et al.* shows, teaches or suggests a setting phase in which at least one reference code and at least one setting code are input and are stored in a memory in a mutual coupled relationship as claimed in claims 1, 12 and 13. Rather, *Hart Jr. et al.* merely discloses printing barcodes on a control document as pointers to mailpiece records.

Furthermore, *Hart Jr. et al.* merely discloses that a header of a mailing control file defines set up parameters for the mailing job. Nothing in *Hart Jr. et al.* shows, teaches or suggests storing a reference code and a setting code in a memory in mutual coupled relationship as claimed in claims 1, 12 and 13. Rather, *Hart Jr. et al.* merely discloses a header defining set up parameters for a mailing job.

Also, *Hart Jr. et al.* merely discloses that records comprising job parameters include unique identification codes, but the job parameters are not stored in coupled relationship with a reference code representing a given item-type property of physical postal items as claimed in claims 1, 12 and 13.

Additionally, *Hart Jr. et al.* merely discloses generating documents 46 and generating and outputting a mailing control file 80. Nothing in *Hart Jr. et al.* shows, teaches or suggests a) a setting phase in which a reference code and setting code are input and stored in a memory in a mutual coupled relationship and b) a startup phase in which a physical (actual) postal item is scanned, extracted or sensed and a code is generated and compared with the reference code input and stored in the memory as claimed in claims 1, 12 and 13. Rather, *Hart Jr. et al.* merely discloses generating document 46 containing a barcode and generating a mailing control file 80. (col. 3, line 53 through col. 4, line 2)

Nothing in *Hart Jr. et al.* shows, teaches or suggests the features as discussed above with regard to claims 1, 12 and 13. Applicants respectfully submit that the claimed invention allows required job settings to be selected on the basis of properties of postal items to be processed thereby obviating the need of manually selecting job settings or providing identification codes of records on control documents. Since nothing in *Hart Jr. et al.* shows, teaches or suggests the invention as claimed in claims 1, 12 and 13, Applicants respectfully request the Examiner withdraws the rejection to claims 1, 12 and 13 under 35 U.S.C. §102(e).

Claims 3-10 and 14 depend from claims 1 and 13 and recite additional features. Applicants respectfully submit that claims 3-10 and 14 would not have been anticipated by *Hart Jr. et al.* within the meaning of 35 U.S.C. §102(e) at least

for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 3-10 and 14 under 35 U.S.C. §102(e).

Claim 11 was rejected under 35 U.S.C. §103 as being unpatentable over *Hart Jr. et al.* in view of *Breese et al.* (U.S. Patent No. 6,353,813).

As discussed above, since nothing in the primary reference to *Hart Jr. et al.* shows, teaches or suggest the primary features as claimed in claims 1, Applicants respectfully submit that the combination of the secondary reference to *Breeze et al.* with the primary reference to *Hart Jr. et al.* will not overcome the deficiencies of the primary reference. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 11 under 35 U.S.C. §103.

The prior art of record, which is not relied upon, is acknowledged. The references taken singularly or in combination do not anticipate or make obvious the claimed invention.

Thus it now appears that the application is in condition for reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge  
our Deposit Account No. 02-4800.

Respectfully submitted,

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